



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,915	07/10/2003	Jerome James Workman JR.	26069-526 CIP	4223

30623 7590 11/02/2006

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY  
AND POPEO, P.C.  
ONE FINANCIAL CENTER  
BOSTON, MA 02111

EXAMINER
----------

SCHUBERG, LAURA J

ART UNIT	PAPER NUMBER
----------	--------------

1657

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/617,915

Applicant(s)

WORKMAN ET AL.

Examiner

Laura Schuberg

Art Unit

1657

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19 and 23-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19 and 23-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election without traverse of Group III (claims 19, 23-43) in the reply filed on 08/18/2006 is acknowledged.

In addition, Applicant elected from the following species:

**Analyte:** lactate

**Skin sensor composition:** mitochondrial stain or dye

**Mitochondrial stain or dye:** 2', 7'-bis-(2-carboxyethyl)-5-(and-6)-carboxyfluorescein (BCECF)

**Dye:** xanthene dyes

**Transport Technique:** wicking

**Predetermined period of time:** from about 5 seconds to 5 minutes

Upon further consideration, the requirement for specie election of predetermined period of time has been withdrawn as the time periods are not found to be patentably distinct from each other.

Claims 1-18, 20-22 and 44-53 have been canceled. Claims 19, and 23-43 are pending and have been examined on the merits.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 31 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrases "at least 24-48 hours" and "at least 2-6 hours" are confusing with regard to the application time period as to whether or not values greater than 48 hours or 6 hours are included or not. A more precise phrasing would be "at least 24 hours" or "at least 2 hours" or another time period that is supported by the specification. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19, 23-26, 28, 29, 32-36, 38, 39, and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Chick et al (US 6,040,194).

Independent claims 19 and 33 are drawn to methods of monitoring the concentration of one or more analytes or *in vivo* blood glucose levels respectively. The methods comprise applying a skin sensor composition to a surface of the skin for a predetermined period of time, wherein the composition comprises one or more of a

Art Unit: 1657

reporter dye and a marker dye; or a dye exhibiting wavelength shift in absorption or fluorescence emission in the presence of a metabolite; causing penetration of the composition to a depth of about 10  $\mu\text{m}$ , wherein said depth corresponds with the bottom of the dead stratum corneum layer, to about 175  $\mu\text{m}$ , wherein said depth corresponds with the top of the dermal layer, into the epidermis; and monitoring a change in concentration of one or more metabolites or analytes by detecting changes in one or more reporter dyes at one or more times using an optical reader. Dependent claims are drawn to the type of stain or dye used, the type of transport technique used, and the minimum wavelength detected being above 450 nm.

The limitation of the depth in the skin of 10  $\mu\text{m}$  to 175  $\mu\text{m}$  is interpreted to mean the epidermal layer of the skin. In addition, this limitation is interpreted as not excluding the dermal layer of the skin as long as the composition passes through the epidermis first.

Chick teaches an *in vivo* method and sensor for detecting an analyte in an individual qualitatively or quantitatively. The sensor is placed in communication with the bodily fluids and once in place the sensor does not exit the skin of the individual. Once the sensor is in place, it is illuminated with radiation transdermally and the fluorescence reagent associated with the presence of the analyte is measured (column 2 lines 31-50. For *in vivo* use, the reagents comprising the fluorescence reagent are placed in, on, or under the skin in communication with (e.g. contacting) body fluid containing the analyte of interest (column 16 lines 24-28). This is interpreted to include the epidermis, thus meeting the limitation for depth in skin of the sensor (claim 19). Wherein glucose is the

Art Unit: 1657

analyte detected is taught (column 6 lines 35-38) as well as wherein the dye is combined with glucose oxidase and uses an oxidative metabolic pathway to measure glucose levels (column 15 lines 35-47) (claims 33 and 24). BCECF is specifically taught as a suitable pH probe (column 14 line 63), which also meets the limitations for a xanthene dye (as identified by Applicant page 8 para 90 of the specification) (claims 23,25,26,34-36). A variety of modes of placing the reactants in communication with the analyte are taught including tattooing and a transcutaneous patch (column 17 lines 6-12) (claims 29 and 39). This would inherently include formulations such as a solvent or a disposable gel film patch as well as wicking (from the patch) as a form of transport for penetration of the skin (claims 28, 29, 38 and 39). In addition, spectra were collected by exciting fluorescein at 472 nm and scanning the emission from 500-650 nm (column 11 lines 39-41) (claims 32 and 42).

Therefore, Chick inherently or explicitly teaches all of the limitations of Applicant's claimed invention and anticipates Applicant's invention as claimed.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1657

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 27, 37 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chick et al (US 6,040,194) as applied to claims 19, 23-26, 28, 29, 32-36, 38, 39, and 42 above, and further in view of Heller et al (US 5,972,199).

Claims 27, 37 and 43 are drawn to the method as described above including lactate as the metabolite elected by Applicant.

Chick teaches the method of Applicant as described above, but does not specifically include lactate as a metabolite to be measured.

Heller teaches that assay of biochemicals, such as glucose and lactate, is important in medicine, biotechnology and food processing (dairy and wine). Heller also teaches that monitoring of lactate in fluids of the human body is of relevance to diagnosis of trauma, of myocardial infarction, congestive heart failure, pulmonary edema, septicemia, hemorrhage, and others (column 1 lines 23-30).

Therefore, one of ordinary skill in the art would have been motivated to use the method of Chick to monitor levels of lactate in a patient because Heller teaches that monitoring of lactate in fluids of the human body is of relevance to diagnosis of trauma,

Art Unit: 1657

of myocardial infarction, congestive heart failure, pulmonary edema, septicemia, hemorrhage, and others (column 1 lines 23-30). One of ordinary skill in the art would have had a reasonable expectation of success because Chick teaches that suitable analytes include inorganic or organic ions (column 5 line 15) and lactate is an ion that is found in bodily fluids.

Therefore, the combined teachings of Chick and Heller render obvious Applicant's invention as claimed.

Claims 30 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chick et al (US 6,040,194) as applied to claims 19, 23-26, 28, 29, 32-36, 38, 39, and 42 above, and further in view of Walt et al (US 6,377,721 B1).

Claims 30 and 40 are drawn to the methods of claims 19 and 33 respectively and includes the additional limitations wherein the penetration depth into the epidermis is accomplished by combining the composition with molecular size attachments.

Applicant defines "molecular size attachments" as adducts to the fluorescent moieties of SMMRs to include, but are not limited to structural modifications of fluorescent SMMRs as the additions to the fluorescence structure of: acetoxy methyl esters and several others (page 14 para 167).

Chick teaches the method of Applicant as described above, using BCECF, but does not specifically teach the use of BCECF with a molecular size attachment.



Art Unit: 1657

Walt teaches that the acetoxymethyl (AM) ester form of BCECF is non-fluorescent in solution, cell membrane permeant and passively enters the cell where, once inside the cell, the lipophilic blocking groups are cleaved by non-specific esterases resulting in an increase in fluorescent intensity. This increase in fluorescent intensity is indicative of the cell viability as a pH indicator (column 16 lines 48-61).

One of ordinary skill in the art would have been motivated to use the acetoxymethyl ester form of BCECF in the method of Chick because Walt teaches that it is a suitable form of BCECF for use as a pH indicator, which is what Chick is using BCECF for (column 14 line 63). One of ordinary skill in the art would have had a reasonable expectation of success because Walt describes how the acetoxymethyl ester form of BCECF passively enters the cell where, once inside the cell, the lipophilic blocking groups are cleaved by non-specific esterases resulting in an increase in fluorescent intensity.

Therefore, the combined teachings of Chick and Walt render obvious Applicant's invention as claimed.

Claims 19, 31, 33, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chick et al (US 6,040,194).

Claims 19 and 33 are drawn to the methods as described above.

Claims 31 and 41 are dependent on claims 19 and 33 respectively and include the additional limitations of the predetermined time period that the skin sensor composition is applied for.

Chick teaches the method of claims 19 and 33 as described above, but does not specifically indicate the time period of application.

The application time for the sensor composition would clearly be a result effective variable since the penetration of the skin by the skin sensor would be required for the proper monitoring of the metabolites and analytes of an individual. The accuracy of the results of the method would indicate if the sensor composition had been applied for a sufficient amount of time. In addition, different formulations of sensor compositions would require different application times as well. According to 2144.05 of the MPEP, "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Therefore, the selection of a specific application time clearly would have been a routine matter of optimization on the part of the artisan of ordinary skill, said artisan recognizing that the accuracy of the method and the formulation of the sensor composition would be dependent upon the application time.

Therefore, the teachings of Chick render obvious Applicant's invention as claimed.

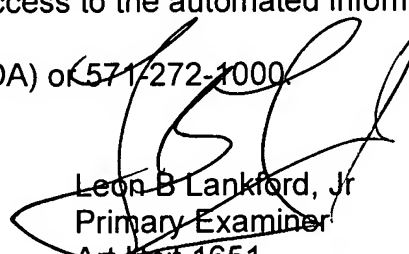
**Conclusion**

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura Schuberg whose telephone number is 571-272-3347. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Leon B Lankford, Jr  
Primary Examiner  
Art Unit 1651

Laura Schuberg